

### REMARKS

Applicants respectfully request consideration of the subject application. This Response is submitted in response to the Office Action mailed October 24, 2008. Claims 1, 2, 6, 7, 9, and 10 are pending. In this Amendment, claim 1 and 2 have been amended, claims 3-5 and 8 have been canceled, and claims 11 and 12 have been withdrawn. No new matter has been added.

Applicants reserve all rights under the doctrine of equivalents.

#### 35 U.S.C. § 112 Rejections

Claims 2 and 4 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, for claim 2, the Examiner asserts that the term “‘high’ temperature is indefinite because one does not know how high is ‘high.’” Applicants have amended claim 2 to claim “ginseng treated by heat.” No new matter is added, because support for the amendments can be found at p. 5, line 26 – p. 6, line 4 of applicants’ specification as filed. Applicants respectfully submit that claim 2, as amended, comply with 35 U.S.C. § 112, second paragraph.

Furthermore, with regards to the subject matter of presently canceled claim 4 and now incorporated in independent claim 1, the Examiner asserts that she is not clear on the meaning of the claim. Applicants respectfully submit that the ginsenosides described in the expression of ‘(ginsenoside Rc + ginsenoside Rd + ginsenoside Rb1 + ginsenoside Rb2 + ginsenoside Re + ginsenoside Rg1)’ are those included in ginseng which is not fermented by bifidobacterium. In other words, the amount of (ginsenoside Rc + ginsenoside Rd + ginsenoside Rb1 + ginsenoside Rb2 + ginsenoside Re + ginsenoside

Rg1) described means the total amount of ginsenosides included in ginseng before the fermentation by bifidobacterium. Where the ginseng is fermented by bifidobacterium of the present invention, the ginseng saponin including ginsenosides Rb1, Rb2 and Rc will be bio-converted to compound K, ginsenoside Rh1, ginsenoside Rh2 or  $\Delta$ 20- ginsenoside Rh2 which is not contained or is contained at an extremely lower level to increase the amount thereof (See p. 5, lines 18-25 of the specification). In this respect, the ginseng is treated with the bifidobacterium of the present invention, the amount of compound K, ginsenoside Rh1, ginsenoside Rh2 or  $\Delta$ 20- ginsenoside Rh2 of the fermented ginseng is increased and thus the whole amount of (Compound K + ginsenoside Rh1), (ginsenoside Rh1 + ginsenoside Rh2), (ginsenoside Rh2 +  $\Delta$ 20 ginsenoside Rh2 + ginsenoside Rh1) or (Compound K + ginsenoside Rh1 + ginsenoside Rh2) be included respectively in the ratio of more than 0.1 with respect to total amount of (ginsenoside Rc + ginsenoside Rd + ginsenoside Rb1 + ginsenoside Rb2 + ginsenoside Rc + ginsenoside Rg1). For example, as shown in table 2, the whole amount of (Compound K + ginsenoside Rh1) with respect to the total amount of (ginsenoside Rc + ginsenoside Rd + ginsenoside Rb1 + ginsenoside Rb2 + ginsenoside Rc + ginsenoside Rg1) was less than 0.01 prior to the fermentation by the bifidobacterium of the present invention but it was increased to more than 0.2 after the fermentation. Applicants respectfully submit that claim 1, as amended, comply with 35 U.S.C. § 112, second paragraph.

Accordingly, applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 112.

#### 35 U.S.C. § 102 Rejections

Claims 1, 6-7, and 9 are rejected under 35 U.S.C. § 102(b) as being anticipated by **Ishida et al.** (JP 63216432 A).

Ishida discloses obtaining a yogurt that contains a medicinal ginseng, where the ginseng does not have any muddy odor and bitterness peculiar to the ginseng. Ishida further discloses adding lactic acid to the medicinal ginseng and carrying out lactic acid fermentation under anaerobic conditions, preferably between 35-45° C.

Claim 1, as amended, recites:

Lactic fermenting products of ginseng prepared by the fermentation of ginseng with lactic acid bacteria capable of bio-converting ingredients of ginsenosides, wherein said lactic acid is *bifidobacterium* KK-1, the total amount of (Compound K + ginsenoside Rh1), (ginsenoside Rh1 + ginsenoside Rh2), (ginsenoside Rh2 +  $\Delta^{20}$ - ginsenoside Rh2 + ginsenoside Rh1) or (Compound K + ginsenoside Rh1 + ginsenoside Rh2) is respectively in the ratio of more than 0.1 with respect to the amount of (ginsenoside Rc + ginsenoside Rd + ginsenoside Rb1 + ginsenoside Rb2 + ginsenoside Rc + ginsenoside Rg1).

(Claim 1, as amended). In claim 1, applicants claim “fermentation of ginseng with lactic acid bacteria capable of bio-converting ingredients of ginsenosides, wherein said lactic acid is *bifidobacterium* KK-1.” Although Ishida discloses lactic acid fermentation, Ishida does not disclose lactic acid fermentation, where the lactic acid is *bifidobacterium* KK-1. Thus, Ishida does not disclose this claimed limitation.

Furthermore, independent claim 1 incorporates the subject matter from presently canceled claims 4 and 5. Because the Examiner does not use Ishida to anticipate now canceled claim 4 or 5 in the last Office Action, the Examiner tacitly admits that Ishida does not disclose the subject matter of claims 4 or 5. Thus, applicants respectfully submit that Ishida does not disclose “the total amount of (Compound K + ginsenoside Rh1), (ginsenoside Rh1 + ginsenoside Rh2), (ginsenoside Rh2 +  $\Delta^{20}$ - ginsenoside Rh2 + ginsenoside Rh1)” or “(Compound K + ginsenoside Rh1 + ginsenoside Rh2) is

respectively in the ratio of more than 0.1 with respect to the amount of (ginsenoside Rc + ginsenoside Rd + ginsenoside Rb1 + ginsenoside Rb2 + ginsenoside Re + ginsenoside Rg1).”

Accordingly, applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 102.

#### 35 U.S.C. § 102/103 Rejections

Claims 1, 3, 6, 7, 9, and 10 are rejected under 35 U.S.C. § 102(b) as being anticipated by, or in the alternative, under 35 U.S.C. 103(a) as obvious over **Ishida**. In particular, the Examiner asserts that claims 1, 3, 6, 7, 9, and 10 are product-by-process claims. “When the prior art discloses a product which reasonably appears to be identical or only slight different that a product claimed in a product-by-process claim, a rejection based on either section 35 U.S.C. 102 or 35 U.S.C 103 is appropriate.” MPEP § 2114.

Claim 1, as amended, recites:

Lactic fermenting products of ginseng prepared by the fermentation of ginseng with lactic acid bacteria capable of bio-converting ingredients of ginsenosides, wherein said lactic acid is *bifidobacterium* KK-1, the total amount of (Compound K + ginsenoside Rh1), (ginsenoside Rh1 + ginsenoside Rh2), (ginsenoside Rh2 +  $\Delta^{20}$ - ginsenoside Rh2 + ginsenoside Rh1) or (Compound K + ginsenoside Rh1 + ginsenoside Rh2) is respectively in the ratio of more than 0.1 with respect to the amount of (ginsenoside Rc + ginsenoside Rd + ginsenoside Rb1 + ginsenoside Rb2 + ginsenoside Re + ginsenoside Rg1).

(Claim 1, as amended). In claim 1, applicants claim that “the total amount of (Compound K + ginsenoside Rh1), (ginsenoside Rh1 + ginsenoside Rh2), (ginsenoside Rh2 +  $\Delta^{20}$ - ginsenoside Rh2 + ginsenoside Rh1) or (Compound K + ginsenoside Rh1 + ginsenoside Rh2)” is respectively in the “ratio of more than 0.1 with respect to the amount of (ginsenoside Rc + ginsenoside Rd + ginsenoside Rb1 + ginsenoside Rb2 + ginsenoside Re + ginsenoside Rg1).” As per above, Ishida does not disclose this limitation in Ishida’s

resulting product. Thus, because Ishida is missing this ratio of products, Ishida's product is neither the same nor slightly different than applicants' product as claimed in claim 1. Therefore, because Ishida does not disclose the same product or a product that slightly different, Ishida cannot anticipate or render obvious applicants' claimed product.

Accordingly, applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 102 or 35 U.S.C. § 103.

### 35 U.S.C. § 103 Rejections

Claims 1, 3, 6, 7, and 9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over **Ishida et al.** (JP 63216432 A), and **Kim** (US 5,776,460). Applicants respectively submit that the combination does not disclose each and every each and every limitation as claimed in claims 1, 2, 6, 7, and 9.

Kim discloses a process ginseng product with enhanced pharmacological effects is provided due to a heat-treatment at a high temperature of 120° to 180° C. for 0.5 to 20 hours so as to make a ratio of ginsenoside (Rg<sub>3</sub> + Rg<sub>5</sub>) to (Rc + Rd + Rb<sub>1</sub> + Rb<sub>2</sub>) above 1.0. However, Kim does not disclose fermentation.

Claim 1, as amended, recites:

Lactic fermenting products of ginseng prepared by the fermentation of ginseng with lactic acid bacteria capable of bio-converting ingredients of ginsenosides, wherein said lactic acid is *bifidobacterium* KK-1, the total amount of (Compound K + ginsenoside Rh1), (ginsenoside Rh1 + ginsenoside Rh2), (ginsenoside Rh2 +  $\Delta^{20}$ , ginsenoside Rh2 + ginsenoside Rh1) or (Compound K + ginsenoside Rh1 + ginsenoside Rh2) is respectively in the ratio of more than 0.1 with respect to the amount of (ginsenoside Rc + ginsenoside Rd + ginsenoside Rb1 + ginsenoside Rb2 + ginsenoside Re + ginsenoside Rg1).

(Claim 1, as amended). As discussed above, Ishida does not disclose "fermentation of ginseng with lactic acid bacteria capable of bio-converting ingredients of ginsenosides, wherein said lactic acid is bifidobacterium KK-1." Because Kim does not disclose fermentation, Kim does not disclose this claimed element.

Furthermore, neither Kim nor Ishida disclose "ginseng-fermented compositions where the amount of compound K, ginsenoside Rh1, ginsenoside Rh2 or  $\Delta$ 20-ginsenoside Rh2 are increased by the fermentation by bifidobacterium."

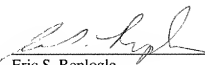
Therefore, the combination of Ishida and Kim do not disclose each and every claim limitation of claims 1, 3, 6, 7, and 9. Accordingly, applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 103.

Applicants respectfully submit that the pending claims overcome the applicable rejections. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call the undersigned at (408) 720-8300.

Please charge any shortages and credit any overages to Deposit Account No. 02-2666. Any necessary extension of time for response not already requested is hereby requested. Please charge any corresponding fee to Deposit Account No. 02-2666.

Respectfully submitted,  
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